

Remarks

In the Office Action mailed October 22, 2003, the Examiner rejected all of the claims as being unpatentable in view of U.S. Patent No. 6,345,095 (Yamartino). In particular, the Examiner rejected claims 1-22 under 35 U.S.C. § 102(e) as being anticipated by Yamartino, and the Examiner rejected claim 23 under 35 U.S.C. § 103(a) as being obvious over Yamartino.

Applicant has amended the claims to more particularly point out and distinctly claim what Applicant regards as the invention. Further, Applicant has cancelled claims 10-13 and 19-20. Thus, now pending in this application are claims 1-9, 14-18 and 21-23, of which claims 1, 5, 15, 21 and 22 are independent and the remainder are dependent.

Applicant respectfully traverses the § 102 and § 103 rejections, because Yamartino fails to disclose or suggest all of the elements of any of the claims. For instance, Yamartino fails to disclose or suggest a method or system in which a subscriber terminal (a) receives a set of digits entered by a user, (b) determines whether the digits match part of a telephone number stored in a phone book and (c) *in response to a determination that the digits do not match part of at least one telephone number stored in the phone book*, (i) prepends a predefined digit sequence to the entered digits so as to establish a composite number, which the subscriber terminal can then use to initiate a call.

This combination of elements is recited in various ways in all of Applicant's claims and is supported by the specification as filed. (See, e.g., page 7, line 20 – page 8, line 4; page 14, line 21 – page 15, line 12.)

Yamartino does not anticipate or render obvious this invention. According to Yamartino, when a user dials a number, a system looks up in a database to determine if the area code and prefix of the number are valid and/or to determine if other area codes could be used instead (in

an area code overlay scenario, for instance). If the system successfully finds a viable area code and/or prefix in the database, the system may then prepend that area code and/or prefix to the dialed number (possibly in place of a dialed area code and/or prefix).

Although Yamartino discloses a database telephone number lookup and Yamartino discloses prepending digits to a dialed number, Yamartino does not disclose or suggest doing what is recited in Applicant's claims. Namely, Yamartino does not disclose or suggest prepending digits to a dialed number *in response to a determination that the dialed number does not match part of at least one phone number in a phone book*. At best, Yamartino teaches finding viable digits in a database and responsively prepending those digits to an entered number. Thus, Yamartino prepends when it successfully finds information in the database, whereas Applicant's invention involves prepending upon *failure* to find a match in a database.

Because Yamartino fails to disclose or suggest all of the elements of any of Applicant's claims, Applicant submits that Yamartino fails to anticipate the claims under § 102 and fails to render the claims obvious under § 103. (See M.P.E.P. §§ 2131, 2143.) Therefore, Applicant submits that all of the pending claims are in condition for allowance, and Applicant respectfully requests favorable action.

Respectfully submitted,

**McDONNELL BOEHNEN
HULBERT & BERGHOFF**

By:


Lawrence H. Aaronson
Reg. No. 35,818

Dated: January 12, 2004